

REMARKS

Status of the Claims

Claims 1, 8, 12-13, 15, 18, 23, 33, 39, 42-43, and 50 are amended; claims 7 and 14 are canceled without prejudice or disclaimer; and new claim 54 is added. New claim 54 finds support, for example, in original claim 14 and throughout the specification. No new matter has been added. Upon entry of this Amendment, claims 1-6, 8-13, 15-24, 26-46, and 49-54 are pending, and elected claims 1-6, 8-13, 15-24, and 53-54 should be examined. Withdrawn claims should be rejoined when base claims are allowed.

General Comments

The Examiner is thanked for his suggestions.

Claim Objections

The Office has objected claims 13, 15, 18, and 23. See Office Action of September 9, 2003, page 4. Each objection is enumerated below.

Claim 13 has been objected on the grounds that the claim allegedly comprises an improper Markush group. As the present version of the claim avoids this issue, the objection should be withdrawn.

Claim 15 has been objected on the basis that the claim allegedly comprises an improper Markush group. As the present version of the claim avoids this issue, the objection should be withdrawn.

Claim 18 is objected for alleged language informalities. As the present version of the claim avoids this issue, the objection should be withdrawn.

Claim 23 is objected for alleged language informalities. As the present version of the claim avoids this issue, the objection should be withdrawn.

Rejections- 35 U.S.C. § 112, Second Paragraph

Claims 1-24 and 53 are rejected under 35 U.S.C. §112, second paragraph, for alleged indefiniteness. As there are numerous indefiniteness rejections, each is addressed and enumerated as in the Office Action, pages 4-5.

Claim 1 is rejected on the grounds that the phrase “sequences L1 (or L2) are in an orientation opposite to one another” is allegedly indefinite. The present version of the claim avoids this issue, and therefore, Applicants respectfully request withdrawal of the rejection.

Claim 14 is rejected on the basis that the claim allegedly does not further limit claim 1, upon which it is dependent. As claim 14 has been cancelled without prejudice or disclaimer, the present rejection should be withdrawn.

Claims 17 has been rejected on the grounds that the term “protein of interest” is allegedly unclear. Applicants respectfully traverse this rejection.

A claim is sufficiently definite to satisfy the statutory requirement of 35 U.S.C. § 112, second paragraph, if one of ordinary skill in the art would understand the bounds of the claim when read in light of the specification. Miles Labs., Inc. v. Shandon, Inc., 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993). Most importantly here, a claim is definite if it is amenable to construction, however confusing that task may be. Exxon Res. And Eng., Co. v. United States, 265 F.3d 1371, 60 USPQ2d 1272 (Fed. Cir. 2001). In other words, if the meaning of the claim is discernible, the claim avoids a rejection on indefiniteness grounds. Id.

In this rejection, claim 17 is amenable to claim construction, since the meaning of “protein of interest” is discernible. For example, the specification at page 16, lines 12-19, indicates “the protein of interest can be any protein.” Since the meaning of claim 17 is discernible, claim 17 avoids rejection on indefiniteness grounds. Thus, the rejection should be withdrawn.

Rejections- 35 U.S.C. § 102(b)

Claims 1-2, 4, 7, and 15-18 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Wild et al. (A6 Reference; Gene 1998, vol. 223, pages 55-66). Applicants respectfully traverse this rejection.

A reference anticipates a claim only if that reference explicitly or inherently describes each and every element of the claim. MPEP § 2131. Inherent descriptions must necessarily flow from a disclosure. MPEP § 2131. And if even just one element is absent from the reference's particular disclosure, that disclosure neither describes nor anticipates the claim.

Id. Such is the case in this rejection.

According to the Office, Wild et al. discloses retrofitting pre-existing libraries of transposon insertions with FRT and ori V elements for generating large quantities of genomic DNA fragments. See Office Action, page 3. As such, Wild et al. describes a system for *excising* a DNA fragment using the FLP recombinase. See page 56, first paragraph. Specifically, the excision system of Wild et al. requires *two* plasmids, each having an FRT site that is inserted randomly into the genome. As Wild's random insertion would not necessarily produce a predictable FRT orientation, for this reason alone, Wild et al. does not anticipate the claimed invention. Thus, the rejection is improper and should be withdrawn.

CONCLUSION

As the above-presented amendments and remarks address and avoid all of the rejections presented by the Examiner, withdrawal of the rejections and allowance of the claims are respectfully requested. No new matter has been added.

If there are any questions concerning this application, the Examiner is courteously invited to contact the undersigned counsel or Sean A. Passino (45,943) at 202-295-4166.

Respectfully submitted,

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